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IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

No. 411

MONROE AUTO EQUIPMENT COMPANY,
Petitioner,

v.

SUPERIOR INDUSTRIES, INC.,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

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Respondent prays that this Court deny the Petition For A Writ Of Certiorari.

Statement of the Case

The statement of the case would not be complete without a reference to the fact that the case does not involve an appellate court conflict. On the contrary, both the Sixth and the Ninth Circuit appellate courts have held United States Patent No. 2,896,938 in suit invalid, affirming their District Court rulings of invalidity. Both District Courts found the patent invalid for the same reasons, namely lack of invention over the prior art and anticipation by the prior knowledge and use of the Knoedler Hydro Shock device. The Sixth Circuit Court of Appeals case is *Monroe Auto Equipment Company v. Heckethorn Manufacturing & Supply Company* (No. 15354) decided May 14, 1964 and reported at 141 USPQ 549.

Petitioner's statement of the case, as would be expected, leaves out many other facts detrimental to the Petitioner. It does

not appear necessary, however, to burden this Court with a detailed recital of such facts for the purpose of this proceeding.

Argument

A: *The Alleged Questions Presented*

The first question presented is set forth immediately herebelow:

> "1. May 35 U.S.C. § 103 be made to turn on structural similarity rather than conceptual unobviousness, without regard to well-settled indicia of the latter including extensive prior efforts with failure and the presumption of validity?"

This question has already been answered in the negative by the Ninth Circuit Court of Appeals.

In its appeal to the appellate court Petitioner framed this same question in somewhat different language. In said appeal Petitioner accused the District Court of using "subjective hindsight" as a test of validity rather than looking at the "various objective criteria of invention" (Appendix vii of Petitioner's Writ). The appellate court, however, clearly stated that it had considered all of the arguments advanced by Petitioner as showing "conceptual unobviousness" but still agreed with the District Court that the patent in suit was invalid for lack of invention. The thoroughness of the appellate court's review of Petitioner's so-called "well-settled indicia" of conceptual unobviousness will be apparent by a review of Pages vii to xvi of the appellate court's opinion appearing at the Appendix to Petitioner's Writ.

The second question presented is set forth immediately herebelow:

> "2. Can evidence not clear and convincing be adequate proof of prior knowledge and use?"

The answer to the above question is of course "No".

Petitioner argued before the Ninth Circuit Court of Appeals that the evidence of prior knowledge and use of the Knoedler device was not clear and convincing. The appellate court replied that even though the evidence to support such knowledge and use was not uncontradicted, on the record before the appellate court, this evidence was not clearly erroneous and hence the appellate court refused to reverse the findings of the District Court.

It will therefore be apparent to this Court that the decision of the Ninth Circuit Court does not properly raise either of the questions presented by the Petitioner. With respect to the first question presented, the appellate court carefully reviewed the so-called well-settled indicia of conceptual unobviousness, rather than relying solely on structural similarity. With respect to the second question, the appellate court held that on the factual record before it the evidence of prior knowledge and use was clear and convincing.

Accordingly, Petitioner is really asking this Court to review the facts of this case and render a new decision which Petitioner hopes will be the reverse of the decisions previously rendered in this case.

B. *The Alleged Reasons For Granting The Writ*

The first reason advanced by Petitioner for granting the writ appears immediately herebelow:

> "a. petitioner's patent has been invalidated by a decision in conflict with this Court's decision in *Eibel Co. v. Paper Co.*, 261 U.S. 45 (1923);"

The above reason is completely fallacious because the appellate court decision in this case is in no manner in conflict with this Court's decision in the *Eibel* case. In this case, as in the *Eibel* case, validity depended upon whether or not the small

change made by the patentee amounted to invention. Under the facts of the *Eibel* case it was held that such a small change did amount to invention. Under the facts of the present case, the small change was held to lack invention. The only conflict between the two decisions is in the ultimate outcome, not in the law followed to obtain such outcome.

The second reason advanced by Petitioner for granting the writ appears immediately herebelow:

> "b. it is of public importance to clarify that the statutory requirement of unobviousness is concerned with the character of the inventor's real-life conceptual contribution, not with whether physical devices animated by his conception are more or less similar to what was old, and in this connection to clarify the import of *Lincoln Co. v. Stewart-Warner Corp.*, 303 U.S. 545 (1938) on this frequently recurring point;"

According to the above reason, Petitioner feels it is of public importance for this Court to clarify the import of its decision in the *Lincoln* case. Respondent submits that this Court's decision in the *Lincoln* case is perfectly clear. The appellate court below had no trouble whatever in applying the law of the *Lincoln* case to the factual situation herein. Hence, this second reason advanced for granting the writ is also inadequate.

The third reason advanced by Petitioner for granting the writ appears below:

> "c. the decision below is in conflict, as to standard of proof of prior use and knowledge, with a line of decisions of this Court including *The Barbed Wire Patent*, 143 U.S 275 (1892)."

With respect to this reason, Respondent respectfully points out to this Court that the *Barbed Wire* case is not in point since in that case the anticipation was established solely by oral testimony. In this case the oral testimony establishing evidence of

prior knowledge was supplemented by considerable documentary and physical evidence including Knoedler's catalog sheet, price sheet and patent application (Page xx of Appendix to Petitioner's Writ). This totalitary of evidence constituted "clear satisfactory and beyond a reasonable doubt" proof to the District Court as to the prior knowledge and use. On the record before the appellate court the latter refused to reverse the trial court's findings and substitute its judgment for that of the trial court in weighing the evidence. It is, therefore, untrue that the decision below is in conflict with the standard of proof of prior use and knowledge set forth in various decisions of this Court including the *Barbed Wire* case.

Conclusion

From the foregoing it will be apparent to this Court that the issue involved in this patent case is the usual issue of validity. The applicable law was, in fact, applied below and on its merits the patent in suit found invalid.

The Petitioner having lost both in the Sixth and the Ninth Circuits seeks to create something special which would warrant judicial review by this Court. The questions Petitioner poses do not find support in the record below nor in the decisions of the District or Circuit Courts. In grasping for the special and important reasons which would raise this case from the status of a mundane patent case, Petitioner has presented two questions for granting the writ. Both the questions presented and the reasons advanced for this Court's consideration of the questions, however, are completely spurious. Petitioner's questions therefore fail to define any clear-cut issue warranting this Court's review and Petitioner's Writ should be denied.

Respectfully submitted.

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